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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,139	10/09/2001	Paul W. Rockley	2730	4692

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EXAMINER

DAVIS, DANIEL J

ART UNIT PAPER NUMBER

3731

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,139

Applicant(s)

Examiner

D. Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 10-12, 17-19 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5, 10-12, 17-19 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 23-25 are objected to because of the following informalities: "each tool tip" lacks antecedent basis. For purposes of examination, the claims will be treated as though they depend from claim 30. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 3, 4, 26-28 and 31 rejected under 35 U.S.C. 103(c) as being unpatentable over Wright et al. (US 4,608,050) in view of Andrew et al. (US 6,319,222). Wright discloses an apparatus for the removal of lens tissue (Fig. 1) comprising a first instrument 1 and 2 having a shaft 1 used in irrigation. The instrument has a tip capable of manipulating a cataract. The device further comprises a second instrument 6. The second instrument is a sleeveless aspirator. The instrument comprises a lumen.

Wright is silent about the size of the wound aperture required to insert the second instrument. Nevertheless, Andrew teaches a device used in cataract surgery wherein the surgical device fits within an incision that is about 1 to 2 mm (Abstract) to minimize the damage to the patient and to reduce healing time. Therefore, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to make Wright's second instrument sufficiently small to insert it within an incision of 1 to 2 mm, as taught by Andrew, in order to minimize the damage to the patient and to reduce healing time. The shaft 1 includes a shaft lumen and is attached to a conduit 2 and 8.

Claim 5 is rejected under 35 U.S.C. 103(c) as being unpatentable over Wright in view of Andrew and in further view of McCabe et al. (US 5,562,640). Wright and Andrew meet the limitations of the claims as described heretofore, but fail to disclose, "the first instrument comprising a plurality of irrigation ports." Nevertheless, McCabe teaches a plurality of irrigation ports 44 (Fig. 8, Col. 5, lines 31--et seq.) to decrease fluid pressure. McCabes device is intended to be used in the more general surgical art. However, since lens material is tissue, and cataract surgery is a subset of the more general surgical art, (see the conclusion of this Office action), those in the cataract surgical art would be motivated to look for teachings in the more general surgical art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a plurality of irrigation ports to decrease fluid pressure.

Claims 10, 11 and 29 are rejected under 35 U.S.C. 103(c) as being unpatentable over Wright, in view of Andrew, and in further view of Rockley et al. (US 6,013,049). Wright and Andrew meet some of the limitations of claims 10, 11 and 29. Those limitations are explained in the rejection of claim sets 28 and 30. However, although Wright discloses the use of an ultrasonic vibrating instrument, he discloses that the

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instrument is associated with the irrigating instrument and not the aspirating instrument. Nevertheless, Rockley teaches an ultrasonic aspirating instrument to emulsify the lens. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wright device to give the aspirating device ultrasonic capabilities, as taught by Rockley, thereby having two ultrasonic instruments and decreasing the time to complete the surgery.

Furthermore, Wright fails to disclose a transverse tip. However, Imonti teaches a transverse a tip (Fig. 1) attached to the ultrasonic instrument. The instrument is used in either irrigation or aspiration in cataract surgery. The transverse tip enables a more ergonomic gripping angle during phacoemulsification (Col. 2, lines 6-9). Therefore, it would have been obvious to create a bend in the Wright first instrument so that the instrument may be gripped more ergonomically.

Claims 12, 17-25, 29 and 30 are rejected under 35 U.S.C. 103(c) as being unpatentable over Wright, in view of Andrew, in view of Rockley, and in further view of McCabe. Wright, Andrew and Rockley meet some of the limitations of claim 12, 17-19, 29 and 30 as described heretofore, but fail to disclose "a coupling medium for removably coupling each of said plurality of tool tips to said shaft." The Nevertheless, McCabe teaches in Figs. 12A-14B a series of interchangeable tool tips attached to an irrigation and aspiration surgical tool used to manipulate tissue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wright device as taught by McCabe to include a coupling medium with

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interchangeable tips enabling a user to manipulate tissue in a various ways as needed by a user.

With respect to claims 23-25, the tool tips disclosed in Figs. 14A and 14B are in the form of a blade and a hook and are transverse to the shaft.

Response to Arguments

Applicant's arguments with respect to all claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Steppe (US 5,217,465) and Baerveldt et al. (US 2002/011608). Kraff et al. (US 5,667,489; col. 1, lines 5-9) teaches that the cataract surgery is a subset of the more general surgical art and both comprise the same of area of endeavor.

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR

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1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge will not apply.

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD
February 3, 2004



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